

SN. 09/737,280

ATTORNEY DOCKET No. CANO:016

REMARKS

Claims 1-23, 47-65, 75, 76, and 78 will remain pending in this application upon entry of the present Amendment. Non-elected claims 24-46, 66-74, and 77 have been canceled. Applicants therefore seek reconsideration of examined claims 1-23, 47-65, 75, 76, and 78.

Amendment

Independent claims 1, 47, 48, 57, 75, 76, and 78 have been amended to more clearly recite the present invention and to improve their form. Specifically, the independent claims have been amended to positively recite the receiving section and the transporting section for added clarity. No new matter has been introduced.

Art Rejection

Claims 1-23, 47-65, 75, 76, and 78 were rejected under 35 U.S.C. § 103(a) as unpatentable over each of Inoue (USP 5,159,546) and Nyffenegger (USP 5,826,869). Applicants traverse these rejections because these references would not have taught controlling the feeding of insert sheets as set forth in independent claims 1, 47, 48, 57, 75, 76, and 78.

First, applicants previously traversed these rejections on the ground that the examiner does not explain how the claims are being rejected. Applicants believe that the examiner still does not set forth how the examiner is applying these references, particularly regarding Inoue. That is, the examiner still does not state what these references teach and what they lack vis-a-vis the claimed limitations. See for instance, paragraph 2 of the Detailed Action, regarding the rejection of claims 1, 47-49, 54, 55, 57, 58, 75, 76, and 78, where the examiner merely lists what the claims call for and only partially matches corresponding elements to that of Inoue, but does not explain anywhere where Inoue supports the elements not matched with corresponding elements. Again, applicants request the examiner to fully explain as is required under Rule 104 should the examiner maintain the same rejection.

Claims 1, 47, 76, and 78 call for controlling the feeding of insert sheets from a plurality of inserter trays. The inserter trays hold insert sheets, which are for inserting between the

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recording sheets transported from an image forming apparatus. The examiner states that Inoue discloses a plurality of inserter trays, referring to Fig. 30, element 2002. Fig. 30 indeed illustrates a plurality of trays. But Inoue discloses only a SINGLE manual insertion tray 1016. The rest of the trays (namely 1006, 1017) are for holding recording pages to be fed to an imaging device for copying operation. At least in this respect, the rejection based on Inoue is flawed and should be withdrawn.

Moreover, these claims further call for controlling the feeding of insert sheets among at least two sheet feeding modes, including a first sheet feeding mode in which the sheet feeding controller controls the feeders to sequentially feed the insert sheets from a different one of the inserter trays every time an insert sheet is fed, and a second feeding mode in which the sheet feeding controller controls the feeders to sequentially feed the insert sheets from only one of the inserter trays unless the one inserter tray is empty. Neither Inoue nor Nyffenger teaches such claimed features. The examiner merely alleges that such claimed features would have been obvious, without providing any objective teaching or support. At least in this regard, the examiner failed to provide a prima facie case of obviousness. As Inoue and Nyffenger fail to teach the two sheet feeding modes, applicants submit that these claims patentably distinguish over these references.

Claims 48, 57, and 75 call for controlling the feeding of the insert sheets from an inserter tray in at least two stacking modes, without interrupting a job being performed while reloading the insert sheets in the inserter tray. The applied references also do not disclose or suggest this feature. The examiner does not address this aspect of the invention. The examiner merely concludes, without providing any objective teaching or support, that the claimed feature would have been obvious. Again, the examiner failed to provide a prima facie case of obviousness. As Inoue and Nyffenger fail to teach the claimed feature identified above, applicants submit that these claims also patentably distinguish over these references.

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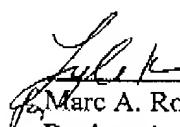
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Conclusion

Applicants submit that claims 1-23, 47-65, 75, 76, and 78 patentably distinguish over the applied references for the foregoing reasons, and thus urge the examiner to issue an early Notice of Allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicants urge the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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